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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,325	07/23/2003	Douglas G. Guenther	WT0115	7745

7590

08/24/2005

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Talk

Office Action Summary

Application No. 10/625,325	Applicant(s) GUENTHER ET AL.	
Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 51-64 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 51-64 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Note the basis for the rejections set forth in the Office Action mailed February 16, 2005. Regarding the added limitation to claim 1, the football taught by the combination of Horkan in view of Martin is obviously capable of being used in competitive play and being grasped by the hand of a user. Horkan particularly teaches that the laces of the ball are enhanced in order to improve grasping thereof by the hand of the user. Further, the projections of Martin when placed on the laces will obviously be projecting outwardly from the football.

3. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Note the basis for the rejections set forth in the Office Action mailed February 16, 2005.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Finley (4,991,842). Note the basis for the rejections set forth in the Office Action mailed February 16, 2005.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a football with lacing having a pebble-like surface.

7. Claims 4, 8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774 in view of Feeney (6,283,881). Feeney teaches projections for a sports ball that are generally triangular and generally rectangular. It would have been obvious to one of ordinary skill in the art to provide the lacing of the patents with differently shaped projections in order to arrange a particular design for the ball while still improving the grip.

8. Claims 5, 7, 9, 10 and 51-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774 in view of Martin (4,570,931). It would have been obvious to one of ordinary skill in the art to form the projections of the patents with the shapes and arrangement of Martin in order to provide an alternative shape and arrangement for the textured surface of the lacing.

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9. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774 in view of Finley (4,991,842). It would have been obvious to one of ordinary skill in the art to provide the surface of the laces of the patent with randomly spaced projections in order to provide a particular design to the laces.

10. Claims 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 5 of U.S. Patent No. 6,629,902 in view of Feeney (6,283,881). Feeney teaches projections for a sports ball that are generally triangular and generally rectangular. It would have been obvious to one of ordinary skill in the art to provide the lacing of the patent with differently shaped projections in order to arrange a particular design for the ball while still improving the grip.

Terminal Disclaimer

11. The terminal disclaimer filed June 10, 2005 is improper as it disclaims a patent that is not set forth in the double patenting rejection. The double patenting rejections rely on U.S. Patent Nos. 6,629,902, 6,767,300, D457,208, and D480,774. The terminal disclaimer disclaims D480,208.

Allowable Subject Matter

12. Claim 11 appears to read over the prior art of record.

Response to Arguments

13. Applicant's arguments filed June 10, 2005 have been fully considered but they are not persuasive. The applicant argues that the reference to Horkan provides a Velcro element on the

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laces and a mating Velcro element on the glove worn by the user. The Velcro material is not placed elsewhere on the ball. The applicant further argues that the Martin reference provides pebbles on the spherical surface of the basketball between the seams thereof. The applicant argues that Martin is devoid of any suggestion to combine the pebbles with the ball of Horkan. However, this is not persuasive as the reference to Martin is relied upon merely for its teaching that it is known in the art of sports balls to provide pebbles or raised surfaces in order to improve the grippability of the ball. The reference to Horkan teaches that it is well known in the art of sports balls and particularly footballs to provide the lacings with a textured surface in order to improve the grippability of the ball. Martin is cited as a secondary reference to replace the textured surface provided by the Velcro element with a raised pebble surface. The suggestion to combine the teachings is that both references are directed towards improved grippability of a sports ball and both particularly teach textured surfaces for achieving this purpose.

The applicant's argument that the combination of the Horkan in view of Martin would change the principle of operation of the football is not seen. Horkan is specifically directed towards a football with improved gripping of the laces by providing a textured surface therefore. Martin is directed to a sports ball where the gripping of the ball is improved by providing a raised pebble surface. Because both references are directed towards improving the grip of their respective game balls, a suggestion to combine the teachings to create laces for a football with a raised pebble surface is seen as being appropriate.

Regarding the applicant's argument that Martin provides seams that are smooth and devoid of any texture, Martin is not relied upon for teaching a roughened or textured surface for

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the seams per se. The reference to Horkan teaches this particular arrangement by providing his laces with a textured surface created by the Velcro element.

14. Regarding the applicant's argument that Horkan provides a football training aid, while this may be true, the ball is also seen as being obviously capable of being used in competitive play. Neither the Velcro element nor the raised pebbled surface (when combined with the teachings of Martin) is seen as precluding the football of Horkan from being used in competitive play. Further, the recitation "for use in competitive play" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding the reference to Feeney, this reference is relied upon merely for its teaching that it is well known in the art of sports balls to provide projections of other shapes:

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Regarding the reference to Finley, this reference is relied upon merely for its teaching that it is well known in the art of sports balls to randomly place projections on the surface of the ball.

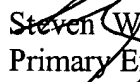
15. Regarding the Terminal Disclaimer, the Disclaimer is improper as it fails to disclaim the patents recited in the Double Patenting Rejection. The double patenting rejections rely on U.S. Patent Nos. 6,629,902, 6,767,300, D457,208, and D480,774. The terminal disclaimer disclaims D480,208.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
August 22, 2005